

## REMARKS

The specification has been amended to add the U.S. patent numbers for previously recited U.S. patent applications. No new matter was added.

Claims 34-80 are pending in the application.

Reconsideration of the present application is respectfully requested.

### **Rejection under 35 U.S.C. 112, first paragraph**

The Examiner has rejected claims 35 and 80 as failing to comply with the written description requirement on the ground that Applicants were not in possession of the gallated and glycosylated procyanidin compounds. The Examiner states that methods of making gallated and glycosylated procyanidin oligomers of the invention are not disclosed in the specification. Applicants respectfully traverse the rejection for the reasons outlined below.

Claims 35 and 80 are directed to methods of anti-platelet therapy or prophylaxis which comprise administration, to a subject in need thereof, of a composition comprising gallated and glycosylated procyanidin oligomers, respectively. A person of skill in the art would have understood that Applicants were in possession of the invention of claims 35 and 80 as of the effective filing date of this application (April 2, 1996) because methods of making gallated and glycosylated procyanidin oligomers were *well known in the art*.

Enclosed is a declaration by Dr. Rebecca Robbins [Robbins Declaration] discussing the knowledge in the art as of April 2, 1996. For example, gallated procyanidin oligomers could have been isolated from natural sources or made using a classical esterification reaction well known to synthetic organic chemists (*see*, paragraphs 12 and 13 of Robbins Declaration). Glycosylated derivatives could have been made using standard chemical techniques (*see*, paragraph 15 of Robbins Declaration). Thus, a person skilled in the art could have practiced the invention of claims 35 and 80 based on the disclosure provided in the specification and the above knowledge of the art. Since the knowledge of making gallated and glycosylated compounds was available in the art prior to the filing of the instant application, under U.S. Patent Law, Applicants' were not

required to include a description of the methodology in the specification. Withdrawal of the rejection is respectfully requested.

With respect to the Examiner's objection that U. S. Patent Application No. 09/289,565 was not properly incorporated by reference, the specification has been amended to include the corresponding U.S. Patent No. 6,156,912. Applicants' believe that the incorporation by reference is now in accordance with the MPEP. Furthermore, the '912 patent does disclose the methods of making gallated procyanidins (see col. 5, lines 49-67; and Examples 6, 7, and 13).

### **Double Patenting Rejection**

The examiner has rejected claims 34, 36-79 of the instant application under 35 U.S.C. § 101 as claiming the same invention as that of (i) claims 209-230 of allowed Application No. 10/127,817 ("the '817 application", now U.S. Patent No. 6,998,417 issued February 14, 2006) and (ii) claims 209-218 of allowed Application No. 10/770,969 ("the '969 application", now U.S. Pat. No. 6,900,241 issued May 31, 2005). Applicants respectfully traverse the rejections for the reasons outlined below.

According to the MPEP Section 804 II A entitled "Statutory Double Patenting – 35 U.S.C. § 101", the "[s]ame invention' means identical subject matter." When determining whether a statutory basis for a double patenting rejection exists, a reliable question to be asked is: "Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist" (emphasis added, see Section 804 II A, 2<sup>nd</sup> par.). Thus, the claims of two applications must be compared, the disclosure of the specification is irrelevant.

#### **Rejection over the '817 application:**

The Examiner did not reject claims 35 and 80 for the same invention double patenting because the claims recite compounds not recited in any of the claims of the '817 application. However, claims 35 and 80 both depend from claim 34, and therefore the scope of claim 34 encompasses gallated and glycosylated procyanidin oligomers, respectively. For this reason claim 34 and other claims that depend from it (claims 36-38,

41-45, 48-52, 55-59, and 62-70) are of different scope than any of the method claims of the '817 application.

Remaining claims 39, 40, 46, 47, 53, 54, 60, 61, 71-79 of the present application also recite compounds different from the compounds recited in the claims of the '817 application, because:

(i) none of the enumerated claims encompass compounds having a sugar moiety at at least one carbon atom position C-4, C-6 or C-8 (see formula in claim 209 of the '817 application) or

(ii) none of the enumerated claims require administration of a cocoa extract, cocoa extract fraction or cocoa-solids or liquor (the compounds recited in the present claims can be in purified form from other plant sources or synthetically prepared as disclosed in the specification, e.g., see page 3 lines 34-38).

Referring to the above, each rejected claim of the present application differs in scope from each claim of the '817 application (claims 209-230) by multiple embodiments. In other words, it is possible to infringe a claim of the present application without infringing a claim of the '817 application. Applicants are entitled to claim their inventions in more than one way. Withdrawal of the rejection is respectfully requested.

#### **Rejection over the '969 application:**

Claims 34 and 36-79 of the present applications recite methods of treatment or prophylaxis which comprise administration of oligomeric compounds (containing at least two monomeric units). Rejected claims are of a different scope because:

(i) method claims 209-218 of the '969 application recite administration of monomeric compounds, or

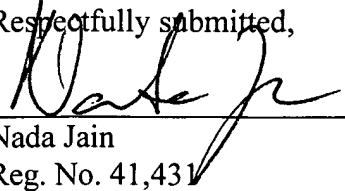
(ii) claims 219-224 of the '969 application recite *an article of manufacture* which is a different statutory subject matter than that recited in the claims of the present application. Again, it is possible to infringe a claim of the present application without infringing a claim of the '969 application. Thus, the same invention is not being claimed twice. Withdrawal of the rejection is respectfully requested.

**Conclusion**

In view of the above remarks, Applicants believe that the application is in condition for allowance. Such action is respectfully requested.

Date: April 17, 2006

Respectfully submitted,

  
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